

REMARKS

Claims in the Application. Claims 1-15, 17-25, 27-32, 35, 46, 49 and 53 are active in this application. Reconsideration is respectfully requested.

Examiner's Rejection of the Claims under 35 USC § 102(b) over Dawson. The Examiner has rejected claims 1-5, 8-12, 14, 15 and 18-21 under 35 USC § 102(b) as being anticipated by US Patent No. 5,465,792 ("*Dawson*"). This ground for rejection is traversed.

Dawson discloses a process for selectively reducing excessive production of fluids within a subterranean formation. In *Dawson*, a superabsorbent material is introduced into a passage of the formation in order to selectively block the water producing zone and thereby permit the superabsorbing particles to swell with the absorption of water. *Dawson* does not disclose a process of inhibiting or controlling inorganic scale formations in a subterranean formation or in a wellbore. In fact, *Dawson* does not reference scale formations, much less inhibition or control of zinc sulfide or iron sulfide scales, as set forth in the claims of Applicants.

The Examiner declines to consider the limitation "wherein the inorganic scale formations are zinc sulfide or iron sulfide scale formations." (Paragraph 3 of Office Action.) The Examiner states that this limitation "does not depend on the preamble for completeness." The Examiner's position is not, however, understood. The limitation to "inorganic scale formations" makes no sense unless coupled with the preamble which recites the inhibition or control of inorganic scale formations in a subterranean formation or wellbore. The term "inorganic scale formations" in the preamble breathes life and meaning into the claims and thus is a necessary limitation of the claims. Applicants' preamble does not "merely recite the purpose of a process or the unique use of the structure", as espoused by the Examiner. In other words, the preamble of Applicants' claims must be considered in order to understand the recitation to the "inorganic scale formations" of "zinc sulfide or iron sulfide" in the body of the claim. Without the preamble, the recitation to zinc sulfide or iron sulfide scales makes no sense.

The Examiner states that "the positively recited process step in claim 1" is the recitation of "pumping downhole". However, the claim also recites that pumping the claimed polymeric composition downhole inhibits or controls scales of zinc sulfide or iron sulfide. When the recitation of "inorganic scale formations" is properly coupled with the preamble directed to the inhibition or control of such an organic scale formations, the claimed process is not anticipated

by *Dawson*. A rejection for anticipation requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. When the recitation to the "inorganic scale formations" is properly coupled to the preamble, it is evident that each and every limitation of Claim 1 is not disclosed in *Dawson*.

Lastly, the Examiner's reliance on *In re Hirao*, 535 F.2d 67 (CCPA 1976) and *Kropa v. Robie* (187 F.2d 150 (CCPA 1951) appears misplaced. In *Hirao*, the issue was whether three process steps were dependent upon the preamble for completeness. In *Hirao*, the first two steps were directed to the process of forming a high purity maltose. The Solicitor argued that the preamble of "a process for preparing foods and drinks sweetened mildly" established that the claimed subject matter as a whole involved the use of an old sweetener in an obvious manner. The Court held that the non-obviousness of the first two steps of the process rendered the claim non-obvious over the prior art and that the claimed process steps were not dependent upon the preamble (for the issue of obviousness under 35 U.S.C. § 103). In the instant case, the references to "inorganic scale formations" and zinc sulfide and iron sulfide are not part of the preamble but appear in the body of the claim. The preamble of Applicants' claim must be coupled to the body of the claim in order for the claim to make sense.

Neither is *Kropa* controlling. In *Krope*, the Court held that the term "abrasive article" in the preamble was a vital term of a count in an interference and must be considered. The Court stated that the preamble terminology of "abrasive article" must be considered because "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article." (at 152).

The Examiner is therefore respectfully requested to consider the claimed terminology of "inorganic scale formations are zinc sulfide or iron sulfide scale formations" as being dependent upon the preamble for completeness and withdraw the rejection of the claims over *Dawson*.

Examiner's Rejection of the Claims Under 35 U.S.C. 103(a). The Examiner has rejected:

- (a) Claim 13 under 35 U.S.C. 103(a) as being unpatentable over *Dawson* in view of U.S. Patent No. 6,123,159 ("*Brookey*");
- (b) Claims 17, 23-25, 28-31, 35, 46, 49 and 53 as being unpatentable under 35 U.S.C. 103(a) as being unpatentable over *Dawson* in view of U.S. Patent No. 4,532,052 ("*Weaver*"); and

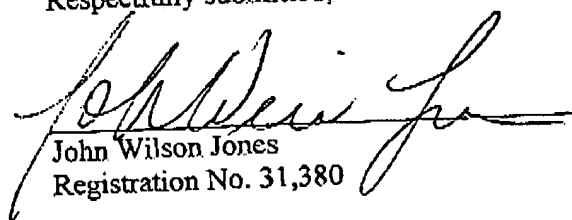
(c) Claim 32 under 35 U.S.C. 103(a) as being unpatentable over *Dawson* and further in view of U.S. Patent No. 4,630,679 ("*Reeves*").

For reasons stated *supra*, *Dawson* is deficient in failing to disclose a process for controlling or inhibiting the formation of zinc sulfide or iron sulfide inorganic scales. None of the secondary references relied upon by the Examiner cure the deficiencies of *Dawson*. Reconsideration of these rejections is therefore respectfully requested.

Conclusions. In view of the foregoing remarks, it is believed that this application is in condition for allowance. Early issuance of a Notice of Allowance is therefore requested.

Respectfully submitted,

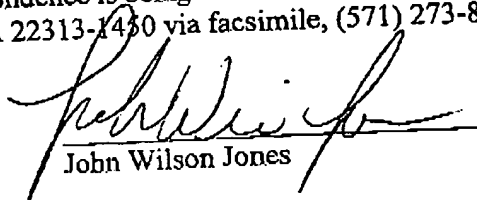
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I hereby certify that this correspondence is being transmitted to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 via facsimile, (571) 273-8300 on this the 6th day of September 2006.


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